



Attorney's Docket No.: 15916-020001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Cale M. Halbleib et al.
Serial No. : 09/918,589
Filed : July 30, 2001
Title : PROCESSES FOR RECEPTOR SCREENING

Art Unit : 1632
Examiner : Joseph F. Murphy

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RESPONSE TO RESTRICTION REQUIREMENT

Claims 1-15 are pending. In the action mailed May 19, 2003, the Examiner stated that claims 1-15 are:

generic to a plurality of disclosed patentably distinct species comprising a method for measuring competitive binding activity of molecules to nuclear receptors wherein the receptors are PPAR, SXR, FXR, LXR, RXR, RAR, TR, ER, PR, GR, MR, AR, and ERR. The methods using each of these receptors are independent and distinct, each from the other, because these receptors possess characteristic differences in structure and function, and each has an independent utility, that is distinct for each receptor . . . Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species . . .

Applicants respectfully traverse the restriction requirement. Applicants respectfully assert that it would not be an undue burden under MPEP § 803.02 or MPEP § 809.02(d) for the Examiner to search the genus of nuclear hormone receptor proteins, because members of the genus are known to be a superfamily having ligand binding domains and DNA binding domains.

Under 35 U.S.C. § 121 and 37 C.F.R. § 1.143, Applicants nevertheless hereby elect the nuclear hormone receptor PPAR, peroxisome proliferator-activated receptor, as the species for examination. Claims 1-3 and 6-12 read on the elected species.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

July 21, 2003
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Angela Montgomery
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Applicants further respectfully remind the Examiner of the provisions of 37 C.F.R. § 1.141, whereby more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims, provided the application also includes an allowable claim generic to all the claimed species (e.g., claim 1). Applicants respectfully suggest that 13 members of a related superfamily, as claimed in claims 2 and 4-5, is not an unreasonable number of species for examination.

Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 7/21/03

Teresa A. Lavoie

Teresa A. Lavoie, Ph.D.
Reg. No. 42,782

Fish & Richardson P.C.
3300 Dain Rauscher Plaza
60 South Sixth Street
Minneapolis, MN 55402
612 335-5070 (phone)
612 288-9696 (fax)